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Application No. 96 932 173.6 - 2221	Ref. NIS/DC/30285	Date 13.06.2003
Applicant Intertrust Technologies Corp.		

Communication pursuant to Article 96(2) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 6 months

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).



ROTHER S
Primary Examiner
for the Examining Division

Enclosure(s): 4 page/s reasons (Form 2906)

**Bescheid/Protokoll (Anlage)**

Datum
Date
Date 13.06.2003

Communication/Minutes (Annex)

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Feuille 1

Notification/Procès-verbal (Annexe)

Anmelde-Nr.:
Application No.: 96 932 173.6
Demande n°:

The examination is being carried out on the **following application documents**:

Text for the Contracting States:

AT BE CH LI DE DK ES FI FR GB GR IE IT LU MC NL PT SE

Description, pages:

1-324 as published

Claims, No.:

1-9 as received on 28.01.2002 with letter of 24.01.2002

Drawings, sheets:

1/98-98/98 as published

Reference is made to the applicant's letter of reply dated 24.01.2002. The solution proposed in independent claims 1, 6 and 7 does not fulfil the requirements of the EPC for the following reasons:

Independent claim 1:

The applicant argues that independent claim 1 has been amended in order to clarify the terms referred to. The examiner considers that there are still remaining different relative terms used in claim 1 which have no well-recognised meaning and leave the reader in doubt as to the meaning of the technical features to which they refer, thereby rendering the definition of the subject-matter of said claim/s unclear (**Article 84 EPC**). For example, the reader is left in doubt as to the meaning of the features "a first control", "a first operation using at least a portion of said data", "being performed in compliance with", "being authorised at least in part by", "one requirement imposed by said first control" etc.

With regard to the last communication dated 11.04.2001, the applicant was asked to explain from which points of the original application documents the amendments of claim 1 (and claims 2-5) were derived because the examiner was unable to identify a basis in the application as originally filed that would support the generalised broad wording of claims 1-5. The applicant cited different pages and figures, but aforementioned amendments still introduce subject-matter which extends beyond the content of the application as filed,



contrary to **Article 123(2) EPC**. The cited pages and figures disclose detailed examples of the features of the invention, but no basis can be found for the very broad wording of claim 1. Thus, the attention of the applicant is drawn to the fact that claim 1 discloses subject-matter which extends beyond the content of the application as filed (**Article 123(2) EPC**).

Thus, claim 1 is also not supported by the description as required by **Article 84 EPC**, as its scope is broader than justified by the description and drawings.

However, as far as claim 1 can be understood, document D1 (EP 0 370 146 A) is considered to represent the closest prior art. It discloses the principal features of claim 1:

- the user side uses digital data and records usage metering data relating to the usage (c.9, l. 19-24; c.12, l. 1-10).
- data is associated with a first control and sent to an external entity, the transmission is authorized (c.12, l.10-30).
- a portion of the data is used in the first or second site ("external service"), a portion of the control remains associated (c.12, l.30 - c.14, l.27).

Thus, the subject-matter of claim 1 even seems to be not new (**Articles 52(1) and 54 EPC**).

Article 82 / Rule 30 EPC:

It is noted that the subject-matter of claims 6 and 7 seems to be non-unitary with that of claim 1 because there are no common or corresponding "special technical features" in the sense of **Rule 30 EPC** to provide unity of invention. The allegedly common features to which the applicant has referred in the letter of reply dated 24.01.2002 are not features of the claimed method but rather a specification of how the clearing process is programmed to process the transmitted data after it has been transmitted from/to the system. These features cannot be considered to imply any particular technical modification of the system itself.

Article 52(2)(3) EPC:

Independent method claim 6 is directed to "a method of performing automated clearing-house functions". The features of this claim are steps of "transmitting secure containers"



depended on certain administrative conditions having purely administrative, actuarial and financial character. Thus, this method claim is entirely characterized by steps of a business method and therefore does not imply a technical character.

The technical features involved in independent claim 6 are defining the individual steps of the claimed method and amount to no more than the general teaching to use data transfer and processing means for processing or providing information of purely administrative, actuarial and financial character, the purpose of each single step and of the method as a whole being a purely economic one.

Thus - having regard to claim 6 - the invention as claimed does not go beyond a method of doing business as such and, therefore, is excluded from patentability under **Article 52(2)(c) EPC** in combination with **Article 52(3) EPC**; the claim does not define an invention within the meaning of **Article 52(1) EPC**.

System claim 7 relates to similar subject-matter as claim 1 so that aforementioned objections apply. **Article 123(2) EPC** is also not fulfilled for the same reasons as objected under item "independent claim 1".

It is not at present apparent which part of the application could serve as a basis for a new, allowable claim. Should the applicant nevertheless regard some particular matter as patentable, an independent claim should be filed taking account of Rule 29(1) EPC. The applicant should also indicate in the letter of reply the difference of the subject-matter of the new claim vis-à-vis the state of the art and the significance thereof.

Where replacement pages are filed the applicant or patent proprietor should, in the interests of procedural efficiency, identify clearly all amendments made, and indicate on which passages of the original application these amendments are based (Guidelines E-II,1).

When filing amended claims the applicant should at the same time bring the description into conformity with the amended claims. Care should be taken during revision, especially of the introductory portion and any statements of problem or advantage, not to add subject-matter which extends beyond the content of the application as originally filed (Article 123(2) EPC).

**Bescheid/Protokoll (Anlage)**

Datum
Date
Date 13.06.2003

Communication/Minutes (Annex)

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Notification/Procès-verbal (Annexe)

Anmelde-Nr.:
Application No.: 96 932 173.6
Demande n°:

The applicant is requested to effect the amendments by filing replacement pages for only those pages which have been amended. Unnecessary recasting of the description should be avoided. An amended abstract is not required. The applicant should also take account of the requirements of Rule 36(1) EPC. If handwritten amendments are submitted, they should be clearly legible for the printer. In particular, fair copies of the amended pages should be filed in triplicate. Replacement pages containing handwritten amendments should also be filed in triplicate.

Information exchanged with the European Patent Office by e-mail has no legal force. Applicants must therefore not use e-mail to perform any procedural act, such as submitting communications subject to time limits (see Guidelines A-IX, 2.5 and C-VI, 6).